

**REMARKS**

In an Office Action dated December 14, 2004, the Examiner rejected Claims 7-9 and 11-14 and made that rejection final. A final rejection is proper on a second or subsequent action except where the examiner introduces a new ground of rejection that is not necessitated by applicant's amendment of the claims. MPEP § 706.07(a). However, this is the first opportunity the Applicants have been given to respond to the rejection of Claim 11. In other words, the rejection of Claim 7 is a new ground of rejection. Because it is the first rejection of Claim 11, it is not a new rejection necessitated by amendment.

The following provides a timeline with respect to the prosecution of Claim 11:

1. May, 6, 2003 The Examiner objected to (did not reject) Claim 11 as being dependent on a rejected base claim but otherwise allowable.
2. July 31, 2003 The Applicants amended Claim 11 to independent form and cancelled Claims 1-6 and 10.
3. March 2, 2004 The Examiner issued an office action that mentioned Claim 11 in the "Office Action Summary" but did not address Claim 11 in the "Detailed Action." Instead, the Examiner mysteriously provided an explanation of a rejection of cancelled Claim 10.
4. December 14, 2004 The Examiner for the first time rejected Claim 11 and provided an explanation in the "Detailed Action."

As this is the first opportunity given the Applicants to respond to a rejection of Claim 11, the Applicants respectfully request that the Examiner withdraw the finality of December 14, 2004 rejection as being premature.

**CLAIM REJECTIONS – 35 USC § 102:** The Examiner rejected Claim 12 as being anticipated by USPN 5,889,578 issued to Jamzadeh. To support a § 102 rejection, the cited reference must teach or suggest the combination of elements required by a rejected claim.

Jamzedah discloses an apparatus for making prints from a roll of photographic film negative strip. The apparatus includes a film scanner capable of scanning frames of a photographic roll of film of a fixed format to generate digital images of the roll's contents. Jamzedah, col. 3, lines 50-62.

Claim 12 is directed to an apparatus for scanning and printing copies of an original image. As amended, Claim 12 requires the following combination of elements:

1. a scan module operable to scan the original image;
2. a print module operable to print copies of the original image;

3. an input device operable to allow one or more photo sizes to be selected; and
4. means for causing the scan module to scan the original image, the means automatically determining an actual size of the original image and scaling scanned copies of the original image to a photo size selected via the input device, the means also causing the print module to print the copies on a sheet.

With respect to the fourth element, the Examiner asserts Jamzedah, col. 3, lines 55-63; col. 7, lines 33-36; and col. 8, lines 1-17 discloses a means for controlling a scanner that automatically determines an actual size of a scanned image. Claim 12 has been amended to clarify that the means recited in element 4 is responsible for determining the actual size of an *original* image and then scaling copies of the *original* image.

The cited sections of Jamzedah disclose a scanner (32) that can read images of film at three resolutions (31 dpi, 250 dpi, and 500 dpi). Jamzedah, col. 3, lines 50-63. The film is scanned at 250 dpi when "normal size prints are to be made." Jamzedah, col. 3, lines 58-60. The film is scanned at 500 dpi when "enlarged prints are requested." Jamzedah, col. 3, lines 60-63. Jamzedah does disclose that an IDM (Image Data Manager (30)) is responsible for instructing scanner (32) to scan film frames at a specified resolution. Jamzedah, col. 7, lines 33-36. Jamzedah, col. 8, lines 1-17 merely discusses the computation of an interpolation ratio and mentions nothing of determining the actual size of the original image.

Jamzedah teaches scanning a frame of a negative strip of a fixed format at a desired resolution. The negative frame (original image) scanned is always the same size – so there would never be a need to identify an actual size of an original image. Consequently, Jamzedah does not teach or suggest a means capable of identifying the actual size of an original image and then generating copies of the original image that are scaled to a particular size as required by the fourth element above. In short, Jamzedah mentions nothing of automatically determining the actual size of the original image scanned. Jamzedah only discloses identifying a particular resolution at which a frame from a roll of film is to be scanned – the particular resolution being chosen according to whether a standard or enlarged photo image is to be printed.

For at least these reasons, Claim 12 is felt to distinguish over Jamzedah. Claims 13 and 14 are also patentable based at least on their dependence from Claim 12.

**CLAIM REJECTIONS – 35 USC § 103:** The Examiner rejected Claim 13 as being unpatentable over Jamzedah in view of USPN 4,582,200 issued to Hicks.

As discussed above, Jamzedah discloses an apparatus for making prints from a negative strip. Hicks discloses a film based camera having an associated input device and memory. Hicks, Fig. 1A. Processing instructions for images taken using the camera are entered through the input device and saved in the memory. Hicks, col. 6, lines 10-60. The processing instructions for a particular image are stored in a memory location that is in some manner associated with that image. Hicks, Col. 7, lines 7-15.

In contrast, Claim 13 depends from Claim 12 and further requires that

1. the input device also allows a Photo Package entry to be selected, and
2. the means scales additional copies of the original image to an additional photo size selected via the input device and causes the additional copies to be printed on an additional sheet when the Photo Package entry is selected.

The Examiner admits that Jamzedah does not teach an input device that allows the selection of a "Photo Package entry" or a means that "causes copies of a different photo size to be printed on an additional sheet when the Photo Package entry is selected." Instead, the Examiner mistakenly relies on Hicks. Specifically, the Examiner cites Hicks, col. 6, lines 20-25, 44-50, and 57-60, col. 10, lines 15-20, and col. 11, lines 25-28 and 35-43.

Hicks, col. 6, lines 20-25 discloses that a package selection is a mixture of various photo sizes of a particular subject. Hicks, col. 6, lines 44-50 discloses that a user can press a code button for a particular package selection for a particular subject to ensure that the subject will receive, at the time the order is processed, photo prints indicate by the package selection. Hicks, col. 6, lines 57-60 discloses that the camera's shutter acts as a trigger to expose film and simultaneously transmit electronic data regarding the particular order (the package selection) to a memory module. Hicks, col. 10, lines 15-20 discloses that a photographic processing sequence once written to memory serves as a source for functions in a commercial photo finishing process. Hicks, col. 11, lines 25-28 discloses a photographic printer that exposes each negative on a roll according to instructions contained in the memory. Hicks, col. 11, lines 35-43 discloses that an exposed roll of prints is mounted to a print cutter that is guided by a microcontroller. Cutting instructions are obtained from the memory.

Contrary to the Examiners assertion, Hicks makes no mention of a means capable of generating second scanned image copies that are scaled to a second photo size when a Photo Package entry is selected and then causing a print module to print the second copies on an additional sheet as required by Claim 13. Hicks does not even disclose generating a scanned copy of an original image. Instead, Hicks discusses dark room methods for producing photo prints from negatives. Hicks, col. 10, line 16 through col. 11, line 13.

For at least these additional reasons, Claim 13 is felt to distinguish over Jamzedah and Hicks.

The Examiner rejected Claim 14 as being unpatentable over Jamzedah in view of USPN 6,236,473 issued to Collard. Claim 14 is felt to distinguish over these references based at least on its dependency from Claim 12.

The Examiner rejected Claims 8 and 9 as being unpatentable over Jamzedah in view of Hicks. Claim 8, as amended, is directed to an apparatus for scanning an original image and printing copies of the original image on a sheet. Claim 8 includes the following combination of elements:

1. a scan module;
2. a print module;
3. an input device for allowing at least a first photo size, a second photo size, and a Photo Package entry to be selected; and
4. a controller for causing the scan module to scan the original image, the controller automatically determining actual size of the original image, generating first scanned image copies that are scaled to the first photo size and that are positioned to utilize maximum printable area on the sheet, and causing the print module to print the first copies on the sheet, and
5. wherein the controller is configured to, when the Photo Package entry is selected, generate second scanned image copies that are scaled to the second photo size and cause the print module to print the second copies on an additional sheet.

The Examiner again contends that Jamzedah teaches a controller that is capable of automatically determining actual size of a scanned image. To this end, the Examiner cites

Jamzedah, col. 7, lines 33-36 and 55-63 and col. 8, lines 8-16. Claim 8 has been amended to clarify that the controller recited in element 4 is responsible for determining the actual size of an *original* image and then scaling copies of the *original* image.

In contrast, Jamzedah, col. 7, lines 33-36 provides that, for enlargement prints, a negative frame will be scanned at a specified full resolution. Jamzedah, col. 7, lines 55-63 discloses that different sized prints can be arranged on a single sheet. Jamzedah, col. 8, lines 8-16 discloses a method for computing an interpolation ratio for resizing a digital image. Jamzedah teaches scanning a frame of a negative strip of a fixed format at a desired resolution. The negative frame scanned is always the same size – so there would never be a need to identify an actual size of an original image. Consequently, Jamzedah does not teach or suggest a controller capable of identifying the actual size of an original image and then generating copies of the original image that are scaled to a particular size as required by the fourth element above. In short, Jamzedah mentions nothing of automatically determining the actual size of the original image scanned. Jamzedah only discloses identifying a particular resolution at which a frame from a roll of film is to be scanned – the particular resolution being chosen according to whether a standard or enlarged photo image is to be printed.

The Examiner mistakenly contends that Hicks teaches the fifth limitation above. Specifically, the Examiner cites Hicks, col. 6, lines 20-25, 44-50, and 57-60, col. 10, lines 15-20, and col. 11, lines 25-28 and 35-43. Hicks, col. 6, lines 20-25 discloses that a package selection is a mixture of various photo sizes of a particular subject. Hicks, col. 6, lines 44-50 discloses that a user can press a code button for a particular package selection for a particular subject to ensure that the subject will receive, at the time the order is processed, photo prints indicate by the package selection. Hicks, col. 6, lines 57-60 discloses that the camera's shutter acts as a trigger to expose film and simultaneously transmit electronic data regarding the particular order (the package selection) to a memory module. Hicks, col. 10, lines 15-20 discloses that a photographic processing sequence once written to memory serves as a source for functions in a commercial photo finishing process. Hicks, col. 11, lines 25-28 discloses a photographic printer that exposes each negative on a roll according to instructions contained in the memory. Hicks, col. 11, lines 35-43 discloses that an exposed roll of prints is mounted to a print cutter that is guided by a microcontroller. Cutting instructions are obtained from the memory.

Hicks makes no mention of a controller capable of generating second scanned image copies that are scaled to a second photo size when a Photo Package entry is selected and then causing a print module to print the second copies on an additional sheet as required by the fifth limitation above. Hicks does not even disclose generating a scanned copy of an original image. Instead, Hicks discusses dark room methods for producing photo prints from negatives. Hicks, col. 10, line 16 through col. 11, line 13.

For at least these reasons, Claim 8 is felt to distinguish over Jamzedah and Hicks. Claim 9, depends from Claim 8 and includes all the limitations of that base claim. For the same reasons Claim 8 is patentable, so is Claim 9.

The Examiner rejected Claim 7 as being anticipated by Jamzedah in view of Hicks and in further view of USPN 6,183,933 issued to Ishikawa. Claim 7, depends from Claim 8 and includes all the limitations of that base claim. For the same reasons Claim 8 is patentable, so is Claim 7.

The Examiner rejected Claim 11 as being unpatentable over Jamzedah in view of Hicks, Collard, and USPN 4,847,662 issued to Yamada. Claim 11 is directed to an article of manufacture for an apparatus including a scan module, a print module, an input device, a display device, and a processor. As amended, the article includes the following combination of elements:

1. computer memory; and
2. a program stored in the computer memory, the program, when executed, commanding the processor to display a Photo Features entry on the display device; the program commanding the processor to command the scan module to perform a pre-scan of an original image when the Photo Features entry is selected via the input device;
3. the program further commanding the processor to automatically determine actual size of the original image after the pre-scan is performed; command the scan module to perform a full scan; generate first scaled copies of an output of the scan module after the full scan is performed, the first copies being scaled to a first size indicated by the selected entry;
4. the program further commanding the processor to rotate the copies if

necessary to utilize maximum printable area on the sheet; and cause the print module to print the first copies on the sheet,

5. wherein the program commands the processor to display a Photo Package entry on the display device, and wherein the controller generates second scaled copies of the output of the scan module, the second copies being scaled to a second size indicated by the selected entry and the controller causes the print module to print the second copies on an additional sheet when the Photo Package entry is selected via the input device.

As above with Claims 8 and 12, the Examiner asserts that Jamzedah teaches a program capable of commanding that an actual size of a scanned image be identified. Claim 11 has been amended to clarify that the program is responsible for commanding the processor to determine the actual size of an *original* image and to generate scaled copies thereof.

As made clear above, Jamzedah teaches scanning a frame of a negative strip of a fixed format at a desired resolution. The negative frame scanned is always the same size – so there would never be a need to identify an actual size of an original image. Consequently, Jamzedah does not teach or suggest a program capable of identifying the actual size of an original image and then generating copies of the original image that are scaled to a particular size as required by the fourth element above. In short, Jamzedah mentions nothing of automatically determining the actual size of the original image scanned. Jamzedah only discloses identifying a particular resolution at which a frame from a roll of film is to be scanned – the particular resolution being chosen according to whether a standard or enlarged photo image is to be printed.

As above with Claim 8, the Examiner mistakenly contends that Hicks teaches the fifth element above. As made clear above, Hicks makes no mention of a program capable of generating second scaled copies that are scaled to a second size when a Photo Package entry is selected and then causing a print module to print the second copies on an additional sheet as required by the fifth element above. Hicks does not even disclose generating a scanned copy of an original image. Instead, Hicks discusses dark room methods for producing photo prints from negatives. Hicks, col. 10, line 16 through col. 11, line 13.

For at least these reasons, Claim 11 is felt to distinguish over Jamzedah, Hicks, Yamada, and Collard.

**CONCLUSION:** The foregoing is believed to be a complete response to the outstanding Office Action. Claims 7-9 and 11-14 are felt to be in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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